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PABLO MELES, ESQ.
AKERMAN, SENTERFITT & EIDSON, P.A.
222 Lakeview Avenue, 4th Floor
P. O. Box 3188
West Palm Beach, FL 33402-3188

EXAMINER

SHARMA, SUZATHA R

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NEIL S. EASTMAN,
MICHAEL ZINGMAN, and MICHELLE SAMMARTINO

Appeal 2009-004684
Application 10/626,244
Technology Center 2600

Decided: November 30, 2009

Before KENNETH W. HAIRSTON, THOMAS S. HAHN, and
CARL W. WHITEHEAD, Jr., *Administrative Patent Judges*.

HAIRSTON, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1 to 26, all of the claims present in the application. We have jurisdiction under 35 U.S.C. § 6(b).

A thorough review of the record before us leads us to conclude that this case is not in condition for a decision on appeal. We will address the deficiencies of the record in further detail below.

The Examiner bears the initial burden of presenting a *prima facie* case of obviousness, and Appellants have the burden of presenting a rebuttal to the *prima facie* case. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

As a result of what appears to be word processing and cut-and-paste mistakes made by the Examiner when issuing the Final Rejection mailed September 25, 2007 (replacing the reference to Ellis with Hilt and Marko), we cannot discern which claims are rejected over which references. The Examiner's mistakes are compounded by (i) Appellants' arguments directed to Ellis in the Brief (*see* Br. 2-3 discussing the rejection of claim 6; Br. 4 discussing the rejection of claims 16, 18, 23, and 25), and (ii) the Examiner's silence in the Answer regarding whether or not Ellis was applied (*see generally* Ans. 13-16). In addition, it is not clear from the record before us that claims 19 and 24 are rejected at all.¹ Accordingly, we remand the application to the Examiner for consideration of our findings, and to take appropriate action.

¹ Although Appellants appeal from the Final Rejection mailed September 25, 2007 finally rejecting claims 1-26, Appellants present numerous issues for review on appeal concerning claims 1 to 18, 20 to 23, 25, and 26 (Br. 1). The Examiner agrees with Appellants' statement of the grounds of rejection and claims to be reviewed on appeal (Ans. 3).

Appellants' invention relates to a computer based multi-channel radio system and user interface (e.g., XM satellite radio) (Spec. ¶¶ [0001]-[0003]; claims 1 and 13). Appellants disclose and claim a single digital audio radio receiver and a graphic user interface (GUI) which simultaneously updates and displays data associated with a plurality of channels (Abstract; claim 1). The data may include channel numbers, artist names, song titles, categories, and use percentages of the channels (claims 1, 6, 16, and 17; Figs. 5-7).

Claim 1, reproduced below, is representative of the subject matter on appeal:

1. A computer based multi-channel radio system, comprising:

a computer coupled to a display and having a graphical user interface;
and

a single digital audio radio receiver coupled to the computer for selectively receiving a plurality of channels and data associated with the plurality of channels from a single data stream over the air, wherein the graphic user interface selectively displays at least a portion of the data associated with the plurality of channels and wherein the data associated with the plurality of channels includes a plurality of channel numbers, a plurality of artist names, a plurality of song titles, and a plurality of channel names and wherein such data associated with the plurality of channels is simultaneously updated and displayed on the graphical user interface.

After review of the record before us, we believe that the prior art relied upon by the Examiner in rejecting the claims on appeal is:

Rindsberg	US 6,553,077 B2	Apr. 22, 2003
Marko	US 2004/0049389 A1	Mar. 11, 2004 (filed Sep. 10, 2002)

Turnbull	US 2004/0196179 A1	Oct. 7, 2004 (filed Apr. 3, 2003)
Sezan	US 7,194,687 B2	Mar. 20, 2007 (effectively filed Mar. 31, 2000)
Hilt	US 2007/0118833 A1	May 24, 2007 (effectively filed Aug. 31, 2001)

After review of the record before us, we believe that the rejections presented for review are as follows:

- (i) Claims 1 to 5, 8 to 12, 20 to 22, and 26 stand rejected under 35 U.S.C. § 103(a) based upon the teachings of Hilt, Marko, and Rindsberg;
- (ii) Claim 6 stands rejected under 35 U.S.C. § 103(a) based upon the teachings of Hilt, Marko, and Rindsberg, further in view of Sezan;
- (iii) Claim 7 stands rejected under 35 U.S.C. § 103(a) based upon the teachings of Hilt, Marko, and Rindsberg, further in view of Turnbull;
- (iv) Claims 13 to 15 stand rejected under 35 U.S.C. § 103(a) based upon the teachings of Hilt and Marko;
- (v) Claims 16, 18, 23, and 25 stand rejected under 35 U.S.C. § 103(a) based upon the teachings of Marko and Rindsberg; and
- (vi) Claims 17 and 24² stand rejected under 35 U.S.C. § 103(a) based upon the teachings of Marko, Rindsberg, and Sezan.

We note that claim 19 does not appear to stand rejected (*see* Ans. 4-12).

² As indicated *supra*, we are not certain that this claim has been presented for review on appeal.

Although the Examiner does not rely on any prior art in the headings of the statements of the rejections in the Answer (*see* Ans. 4-12), other than Rindsberg, Marko, Turnbull, Sezan, and Hilt to reject the claims on appeal, the Examiner discusses Ellis (US 2005/0020223 A1) at pages 8, 9, and 12 of the Answer with respect to the obviousness rejections of claims 6, 7, and 17 and 24, respectively. Figures 26 and 27, along with paragraph 232 of Ellis, were applied in the obviousness rejections presented earlier in the prosecution history (*see* Non-Final Rejection mailed April 17, 2007). The Examiner appears to have withdrawn the rejections based on Ellis in the Final Rejection mailed September 25, 2007, and replaced Ellis with Hilt and Marko. The mention of Ellis in the Answer in the Grounds of Rejection section (Ans. 4-12) is thought to be an oversight by the Examiner. This is supported by the *absence* of any discussion of Ellis in the Answer in the Response to Arguments section addressing the obviousness rejection of claim 6 (*see* Ans. 15-16).

The Examiner also mentions a prior art reference to Acker with respect to claim 2, citing paragraphs 39 to 41 and 83 therein (*see* Ans. 5). Our review of the prosecution history does not reveal any reference to Acker cited by either Appellants or the Examiner. Additionally, the paragraph numbers referenced therein (with respect to the features of claim 2) do not appear to match any other cited or applied reference.

The Examiner bears the initial burden of presenting a *prima facie* case of obviousness, and Appellants have the burden of presenting a rebuttal to the *prima facie* case. *In re Oetiker*, 977 F.2d at 1445. It is readily apparent

from the erroneous record that this case is not in condition to determine whether or not the Examiner has satisfied the initial burden of presenting a prima facie case of obviousness. We leave it to the Examiner on remand to take appropriate action to address the noted errors, and the following errors.

With regard to the rejection of claim 2 (rejection (i) listed *supra*), the Examiner relies upon Acker and cites paragraphs 39 to 41 and 83 of that reference as teaching the recited limitations (*see* Ans. 5). Upon careful review of the prosecution history and prior rejections, including the recent Final Rejection dated September 25, 2007, we are unable to locate any prior reference to Acker.

With regard to the rejection of claim 6 (rejection (ii) listed *supra*), we cannot determine what prior art references the Examiner is attempting to combine, since the Answer (Ans. 7) refers to Ellis and cites portions of Ellis as teaching the features of claim 6. The Examiner appears to have withdrawn the rejection based on Ellis, Rindsberg, and Sezan in the Final Rejection mailed September 25, 2007, and replaced Ellis with Hilt and Marko. Again, the mention of Ellis in the Answer is thought to result from cutting-and-pasting from an earlier Office Action. It is also not clear why claims 17 and 24 are discussed in the body of the rejection since only claim 6 is rejected in the heading of the statement of the rejection.

With regard to the rejection of claim 7 (rejection (iii) listed *supra*), the Examiner again makes reference to Ellis (Ans. 7). This appears to have resulted from cutting-and-pasting from an earlier Office Action. In addition, it appears that claim 19 should be listed with the rejection of claim 7 since

they both recite a signal strength feature. However, our review of the record before us reveals that claim 19 (which depends from claim 16) has not been rejected by the Examiner in the Final Rejection dated September 25, 2007 or the Answer, and Appellants have not asserted otherwise (although this appeal is taken from the final rejection of “claims 1-26” (Br. 1). Although Appellants (i) discuss claim 19 in the arguments concerning the rejection of claim 7, and (ii) claim 19 contains similar signal strength features as claim 7, Appellants recognize in the Brief (Br. 3) that only claim 7 stands rejected by the Examiner over Hilt, Marko, Rindsberg, and Turnbull.

With regard to the rejection of claims 17 and 24 (rejection (vi) listed *supra*), the Examiner again references Ellis (Ans. 12), and fails to address either Marko or Rindsberg which are, according to the heading of the statement of the rejection, the base references combined with Sezan. The Examiner appears to have withdrawn the rejection made in the Non-Final Rejection mailed April 17, 2007 based on Ellis, Rindsberg, and Sezan, and has attempted to replace Ellis with Hilt and Marko in the Final Rejection mailed September 25, 2007. The discussions of Ellis in the Final Rejection dated September 25, 2007, and in the Answer (Ans. 12), are thought to have resulted from cutting-and-pasting from an earlier Office Action. It is also not clear why claim 6 is discussed in the body of the rejection since only claims 17 and 24 are rejected in the heading of the statement of the rejection. Furthermore, Appellants mistakenly state in the Brief that only claim 17 (and not additionally claim 24) is rejected over Marko, Rindsberg, and Sezan (*see* Br. 1, 4). As discussed *supra*, the

Examiner (Ans. 3) agrees with the grounds of rejection set forth by Appellants. However, we find that the heading for the statement of the rejection over Marko, Rindsberg, and Sezan lists both claims 17 and 24 as rejected (*see* Ans. 12). We note the Examiner has not discussed claim 24 in the portion of the Answer responding to Appellants' arguments (*see* Ans. 12-16).

Appellants present arguments (Br. 2-4) with respect to claims 6 (*see* rejection (ii) listed *supra*), and with respect to claims 16 to 18, 23, and 25 (*see* rejection (v) listed *supra*). The Examiner agrees with Appellants' statement (Br. 1) of the grounds of rejection to be reviewed on appeal (*see* Ans. 3). However, our close review of the Final Rejection dated September 25, 2007, and the Answer, reveals that only claims 16, 18, 23, and 25 are rejected (i.e., not including claim 17) (*see* Ans. 9-12). Notably, the text of the rejection in the Answer does not address claim 17 (rejection (ii) listed *supra*; *see generally* Ans. 9-12).

In order for us to review the instant appeal on the merits, a clear indication of the actual references relied upon by the Examiner and reasons for their being combined to establish a prima face case of obviousness is required. In response to this remand, the Examiner should clearly explain which claims are rejected over which combinations of references, and state which claim(s) are not rejected, if that is the case.

Appeal 2009-004684
Application 10/626,244

This application, by virtue of its “special” status, requires an immediate action. *See* MPEP § 708.01. It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

KIS

PABLO MELES, ESQ.
AKERMAN, SENTERFITT & EIDSON, P.A.
222 LAKEVIEW AVENUE, 4TH FLOOR
P.O. BOX 3188
WEST PALM BEACH, FL 33402-3188